



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,289	11/02/2001	Uday C. Sagi	29505/PF02186NA	9027

29978 7590 08/28/2003

MARSHALL, GERSTEIN & BORUN (MOTOROLA)  
233 SOUTH WACKER DRIVE  
SUITE 6300  
CHICAGO, IL 60606-6402

EXAMINER

NGUYEN, DUC M

ART UNIT	PAPER NUMBER
----------	--------------

2685

DATE MAILED: 08/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
10/000,289

Applicant(s)  
Sagi et al

Examiner  
Duc M. Nguyen

Art Unit  
2685



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 6) ☐ Other:

Art Unit: 2685

## DETAILED ACTION

### *Information Disclosure Statement*

1. The references listed in the information disclosure statements submitted on 5/8/03 has been considered by the examiner (see attached PTO-1449).

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. Claims 1-4, 7, 9, 13-15, 17-18, 20-26, 29, 33-34 are rejected under 35 U.S.C. 102(e) as being anticipated by **Ogle** (US Pat. Number 6,430,604).

Regarding claim 1, **Ogle** discloses a system for enabling message system to deliver instant messages to a subscriber based on the subscriber profile (see Abstract, Figs. 5F1, 5F2, 5G) which would include all the claimed limitation, wherein the registry would read on the "subscriber profile" as claimed (see Fig. 3, col. 7, line 23 - col. 8, line 67), the instant messages would read on "real-time communication message" as claimed (see col. 1, lines 20-23).

Art Unit: 2685

Regarding claim **14**, the claim is rejected for the same reason as set forth in claim 1 above. In addition, **Ogle** discloses a gateway and servers as claimed (see Fig. 2, col. 5, lines 20-40).

Regarding claim **23**, the claim is rejected for the same reason as set forth in claim 1 above. In addition, **Ogle** discloses a computer-readable medium as claimed (see col. 6, lines 1-65 and columns 15-16).

Regarding claims **2, 15, 24**, the claims are rejected for the same reason as set forth in claims 1, 13, 23 above. In addition, **Ogle** discloses one of text, voice messages as claimed (see col. 9, lines 43-59).

Regarding claims **3, 17, 25**, the claims are rejected for the same reason as set forth in claims 1, 13, 23 above. In addition, **Ogle** discloses operating information (time) of one of devices as claimed (see Fig. 3).

Regarding claims **4, 18, 26**, the claims are rejected for the same reason as set forth in claims 1, 13, 23 above. In addition, **Ogle** discloses one of informations as claimed (see Fig. 3, col. 7, line 57 - col. 8, line 67).

Regarding claims **7, 29**, the claims are rejected for the same reason as set forth in claim 1, 13, 23 above. In addition, **Ogle** discloses formats conversion as claimed (see Fig. 5F2, ref. 730 and col. 9, lines 43-59).

Regarding claim **9**, the claim is rejected for the same reason as set forth in claim 1 above. In addition, **Ogle** discloses one of formats conversion as claimed (see Fig. 5F2, ref. 730 and col. 9, lines 43-59).

Art Unit: 2685

Regarding claims **13, 22, 33**, the claims are rejected for the same reason as set forth in claims 1, 13, 23 above. In addition, **Ogle** discloses an instant message as claimed.

Regarding claims **20-21**, the claims are rejected for the same reason as set forth in claim 1 above. In addition, **Ogle** discloses protocols as claimed (see Fig. 2, col. 5, lines 44-67).

Regarding claim **34**, the claim is rejected for the same reason as set forth in claim 23 above. In addition, **Ogle** discloses the medium comprises one of components as claimed (see Fig. 2).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims **5-6, 8, 10, 16, 19, 27-28, 30** are rejected under 35 U.S.C. 103(a) as being unpatentable by **Ogle**.

Regarding claims **5-6, 19, 27-28**, the claims are rejected for the same reason as set forth in claims 1, 13, 23 above. In addition, since indicating a preference format for a device in the subscriber profile is known in the art (Official Notice), it would have been obvious to one skill in

Art Unit: 2685

the art to modify **Ogle** for providing a preference format as claimed, for providing the user a personalize service as an enhanced feature.

Regarding claims **8, 30**, the claims are rejected for the same reason as set forth in claims 1, 13, 23 above. In addition, **Ogle** discloses formats conversion in response to a subscriber input as claimed (see col. 10, lines 8-46), wherein it is clear that when selecting an alternative delivery option by the user input which has a different format, the message format would obviously be converted to the alternative delivery format (see col. 8, lines 7-67) in order to delivery the message without error.

Regarding claim **10**, the claim is rejected for the same reason as set forth in claim 1 above. In addition, since such GIF and WBMP formats are known in the art (Official Notice), it would have been obvious to one skill in the art to modify **Ogle** for using format as claimed, for cost saving.

Regarding claim **16**, the claim is rejected for the same reason as set forth in claim 13 above. In addition, since routing a multi-media message is known in the art (Official Notice), it would have been obvious to one skill in the art to modify **Ogle** for providing a message as claimed, for providing the service as an enhanced feature to users.

6. Claims **11-12, 31-32** are rejected under 35 U.S.C. 103(a) as being unpatentable by **Ogle** in view of **Woltz** (US Pat No. **6,216,165**).

Art Unit: 2685

Regarding claims **11-12, 31-32, Ogle** discloses all the claimed limitations, see claim 1 above, except for the message is routed to two devices. However, in an analogous art, **Woltz** also discloses a system for enabling message system to deliver a message to a subscriber based on the subscriber profile, wherein a first component (header notification) and a second component (content information, newsletter) of the message are delivered each to a different device (see col. 5, line 60 - col. 6, line 14). Therefore, it would have been obvious to one skill in the art to provide the above teaching of **Woltz** to **Ogle** for sending components of message to two different devices at two formats as claimed, as an enhanced service to the user (i.e, a traveling user would be aware of a message have been received at home).

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- **Jonsson** (PCT Pub. Number WO 02/35778), A multi device router.

8. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, please label "PROPOSED" or "DRAFT")

Serial Number: 10/000,289

Page 7

Art Unit: 2685

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Sixth Floor (Receptionist).

Any inquiry concerning this communication or communications from the examiner should be directed to Duc M. Nguyen whose telephone number is (703) 306-4531, Monday-Thursday (9:00 AM - 5:00 PM). Or to Edward Urban (Supervisor) whose telephone number is (703) 305-4385.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Duc M. Nguyen

May 28, 2003

